

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed October 8, 2008.

In the Office Action, the Examiner rejected claims 6-10 under 35 U.S.C. § 101 and claims 1-10 under 35 U.S.C. § 103.

Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 101

For the first time, after many previous Office Actions, the Examiner rejects claims 6-10 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

The Examiner asserts that independent claim 6 “is not directed to a machine, but rather a program or code.” (Office Action, page 3).

Applicant respectfully disagrees with the Examiner. Claim 6 is directed to a “content delivery system for distributing advertising data to a network of personal computers... comprising: an identification database...an advertisement database...a collection module...a formatting module...and...a control module...” Each of these system or machine components performs described functions.

As set forth in MPEP § 2106.IV.A, “Accordingly a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under that is made by man is the proper subject matter of a patent.” (Emphasis added).

As set forth in MPEP § 2106.IV.B, “For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine...an apparatus claim with process steps is not classified as a

‘hybrid’ claim, instead, it is simply an apparatus claim including functional limitations...”
(Emphasis added).

As recently set forth by the Federal Circuit in the In re Bilski decision (Fed. Cir. 2008): A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Applicant respectfully submits that the content delivery system of independent claim 6 clearly sets forth a particular system or machine that performs well-defined process steps and is clearly statutory subject matter under 35 U.S.C. § 101.

Applicant respectfully requests that the Examiner remove this ground for rejection.

Rejection Under 35 U.S.C. § 103

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 5,948,061 issued to Merriman et al. (hereinafter Merriman) in view of U.S. Patent No. 6,373,498 issued to Abgrall (hereinafter Abgrall).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In KSR International Co. vs. Teleflex, Inc., 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an

explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 127 S.Ct. at 1741, quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

Further, as is well known in obviousness determinations, *impermissible hindsight must be avoided*. MPEP § 2141. To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453.

Applicant respectfully submits that there is no teaching, suggestion, or rational reasoning as set forth by the Examiner to combine Merriman and Abgrall, and thus, no *prima facie* case of obviousness has been adequately established, and further, even if Merriman and Abgrall were properly combinable, their combination would not teach or suggest the limitations of independent claims 1 and 6.

Applicant respectfully submits that the Examiner has misinterpreted the teachings of Merriman and Abgrall, and that the combination of Merriman and Abgrall, even if they were properly combinable, does not teach or suggest the limitations of Applicant’s independent claims.

As recognized by the Examiner, on page 4 of the Office Action, Merriman does not disclose the following limitations: “*wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.*”

The Examiner asserts that Abgrall teaches these limitations. Applicant respectfully disagrees and believes that the Examiner has misconstrued the teachings of Abgrall. Abgrall does not teach or suggest these claim limitations.

In contrast to Applicant's claims, Abgrall is directed to an: "invention that relates to graphics...In particular, the invention relates to graphics display." (Abgrall, col. 1, lines 7-8, emphasis added). Even more particularly, Abgrall is directed to: "a method and apparatus to display an image during a transition of an operating system in a computer system. An image having an image format compatible with the operating system is obtained. Content of a system file corresponding to the transition of the operating system is created using the image in a system directory." (Abgrall, Summary, col. 1, lines 30-35, emphasis added).

Abgrall in no way relates to *personal computers that periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.*

The Examiner relies upon Column 3 line 54 through Column 4 line 31 of Abgrall for these alleged teachings. However, Applicant respectfully submits that this section of Abgrall in no way teaches or suggest these limitations. This section of Abgrall merely describes that after a program is downloaded by a user that a display screen may used to provide customized screens in the form of messages or graphics prior to and during the booting of the OS. (Abgrall, col. 4, lines 9-13).

There is no mention or description of advertisements at all in Abgrall.

Applicant respectfully submits that it is clear that the Examiner *has misinterpreted the teachings of* Abgrall and that Abgrall relates to the display of graphic display images during a transition of an operating system in a computer system and does not teach or suggests *personal computers that periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.*

These claim limitations are nowhere taught or suggested by Merriman or Abgrall. Further, Applicant respectfully submits that there is no rational reason set forth by the Examiner to combine Merriman and Abgrall, except for “impermissible hindsight”, to attempt to reconstruct Applicant’s claims, which is improper.

As set forth in detail above, Applicant respectfully submits that Merriman and Abgrall, either alone or in combination, do not teach or suggest the limitations of Applicant’s independent claims 1 and 6. Further, as previously discussed, Merriman and Abgrall are not properly combinable.

Therefore, Applicant respectfully submits that independent claims 1 and 6, and the claims that depend therefrom, are distinguishable over the prior art references, and Applicant respectfully requests that these claims be allowed and passed to issuance.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1-10 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Attachments

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